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PATENT APPLICATION

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, Colorado 80527-2400ATTORNEY DOCKET NO. 10003824 -1IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): David W. Boyd et al

Confirmation No.: 9177

Application No.: 08/824117

Examiner: Sana A. Al Hashemi

Filing Date: Apr 02, 2001

Group Art Unit: 2164

Title: Envelope Printing Feature For Photo Filing System

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Commissioner For Patents  
PO Box 1450  
Alexandria, VA 22313-1450TRANSMITTAL OF APPEAL BRIEFTransmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on herewith.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.138 (fee: 37 CFR 1.17(a)-(d)) for the total number of months checked below:☐ 1st Month  
\$120☐ 2nd Month  
\$450☐ 3rd Month  
\$1020☐ 4th Month  
\$1690☐ The extension fee has already been filed in this application.☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2026 the sum of \$ 500 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2026 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2026 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Typed Name: Carrie McKay

Signature: Carrie McKay

Respectfully submitted,

David W. Boyd et al

By: [Signature]

Phillip S. Lyren

Attorney/Agent for Applicant(s)

Reg No.: 40,709

Date: April 13, 2006

Telephone: 281 514 8238

Rev 10/05 (ApBrief)

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PATENT APPLICATION

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Inventor(s): David W. Boyd et al

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Typed Name: Carrie McKenney

Signature: Carrie McKenney

Respectfully submitted,

David W. Boyd et al

By: Phillip S. Lyren

Phillip S. Lyren

Attorney/Agent for Applicant(s)

Reg No.: 40,709

Date: April 13, 2006

Telephone: 281 514 8236

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants:	David Boyd, et al.	Examiner:	Sana Al-Hashemi
Serial No.:	09/824,117	Group Art Unit:	2164
Filed:	April 2, 2001	Docket No.:	10003824-1
Title:	Envelope Printing Feature for Photo Filing System		

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is filed in response to the Final Office Action mailed January 24, 2006.

**AUTHORIZATION TO DEBIT ACCOUNT**

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

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### **I. REAL PARTY IN INTEREST**

The real party-in-interest is the assignee, Hewlett-Packard Company, a Delaware corporation, having its principal place of business in Palo Alto, California.

### **II. RELATED APPEALS AND INTERFERENCES**

There are no known related appeals or interferences known to appellant, the appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Appeal Board's decision in the pending appeal.

### **III. STATUS OF CLAIMS**

Claims 33 – 45 and 53 – 63 stand finally rejected. The rejection of claims 33 – 45 and 53 – 63 is appealed.

### **IV. STATUS OF AMENDMENTS**

No amendments were made after receipt of the Final Office Action. All amendments have been entered. Claims 1 – 32 were previously canceled, and claims 46 – 52 were previously withdrawn. Claims 33 – 45 and 53 – 63 are pending in the application and subject of this appeal.

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### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The following provides a concise explanation of the subject matter defined in each of the claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R.

§ 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element or that these are the sole sources in the specification supporting the claim features.

#### **Claim 33**

A method comprising:

using a camera to capture at least one image (FIG. 1, #101: p. 6, lines 1-16);

using said camera to capture information associated with said image, wherein said information is stored in a database (FIG. 1, #101-106: p. 6, line 7 – p. 7, line 27); and

using said information to generate a physical label having an identifier, wherein the label is adapted to be affixed to a storage device that is adapted to hold printed copies of the plurality of images (FIG. 1, #108-110: p. 8, lines 1-24).

#### **Claim 35**

The method of claim 33, wherein capturing said information comprises:  
forming metadata during said capture of said image (p. 7, lines 6-16).

#### **Claim 42**

The method of claim 33, further comprising:

searching the database with a query to locate a printed copy of one image of the plurality of images (FIG. 2, #201: p. 8, line 25 – p. 9, line 7);

providing the identifier associated with the one image (FIG. 2, #202-203: p. 9, lines 8-14);

locating the storage container with the label having the identifier (p. 9, lines 13-16);

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searching the storage container for the printed copy of the one image (p. 9, lines 13-16).

**Claim 44**

The method of claim 33 further comprising:

forming a thumbnail representation of the image on the label (p. 8, lines 14-15).

**Claim 45**

The method of claim 44, further comprising:

searching the database with a query to locate the printed copy of the image (FIG. 2, #201-202: p. 8, line 25 – p. 9, line 9); and  
providing the thumbnail representation of the image (FIG. 2, #203: p. 9, lines 9-11).

**Claim 53**

A method comprising:

generating information identifying an image at the time said image is captured (FIG. 1, #101: p. 6, lines 1-16);  
automatically producing meta-data associated with said image (FIG. 1, #103: p. 6, lines 8-16; and p. 7, lines 6-16);  
providing the meta-data into a database (FIG. 1, #105: p. 7, lines 21-22);  
generating a physical label that is adapted to be affixed to a storage device adapted to hold a printed copy of said image, wherein said label has an identifier generated from said identifying information (FIG. 1, #108-110: p. 8, lines 1-24); and  
providing said identifier into said database (p. 8, lines 8-14).

**Claim 54**

The method of claim 53 wherein said identifying information is automatically generated by a device capturing said image. (p. 7, lines 6-16)

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**Claim 55**

The method of claim 53 further comprising:  
providing a thumbnail representation of the image into the database (FIG. 1, #105: p. 7, lines 21-22); and  
printing the thumbnail representation on the label (p. 8, lines 14-16).

**Claim 59**

A method comprising:  
capturing a plurality of images with a digital camera (FIG. 1, #101: p. 6, lines 1-16);  
inputting, from a user into said digital camera, user data associated with each said image (FIG. 1, #104: p. 7, lines 17-20);  
automatically generating, with said digital camera, meta-data associated with each said image, wherein said meta-data comprises said user data, and wherein said meta-data for each said image is generated at a time said image is captured (FIG. 1, #103: p. 6, lines 8-16; and p. 7, lines 6-16);  
providing each said image and its associated meta-data into a computer (FIG. 1, #105: p. 7, lines 21-22); and  
generating a label to affix to a storage device for holding a printed copy of said images, wherein said label identifies said printed copies with an identifier image generated from said meta-data (FIG. 1, #108-110: p. 8, lines 1-24).

**Claim 60**

The method of claim 59 further comprising:  
generating a thumbnail of said image on said label (p. 8, lines 14-16).

**Claim 63**

The method of claim 59 further comprising:  
storing, in said computer, said meta-data, said user data, and said identifier (FIG. 1, #105: p. 7, lines 21-22).

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**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

I. Claims 33-45 and 53-63 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

II. Claim 33 is rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement.

III. Claims 33-39, 40-45, 53-55, and 60-63 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,483,570 (Slater) in view of USPN 6,629,104 (Parulski).

IV. Claims 39 and 56-58 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,483,570 (Slater) in view of USPN 6,629,104 (Parulski) and USPN 6,426,801 (Reed).

V. Claim 39 is rejected under 35 USC § 103(a) as being unpatentable over USPN 6,483,570 (Slater) in view of USPN 6,629,104 (Parulski) and USPN 6,813,395 (Kinjo).



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## **VII. ARGUMENT**

The rejection of claims 33 – 45 and 53 – 63 is improper, and Applicants respectfully requests withdraw of this rejection.

The claims do not stand or fall together. Instead, Applicants present separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

### **I. Claims Rejections: 35 USC§ 112**

Claims 33-45 and 53-63 are rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. This rejection is traversed.

#### **Overview of Law**

The purpose of the written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that the inventor had *possession*, as of the filing date of application relied upon, of the specific subject matter later claimed by him. *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *Application of Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). This possession requirement ensures that the applicant actually invented the later claimed subject matter at the time the patent application was filed. As stated by the Court of appeals for the Federal Circuit (hereinafter “Federal Circuit”):

Satisfaction of the description requirement ensures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that a *prima facie* date of invention can fairly be held to be the filing date of the application. (See *Etselstein v. Frank*, 52 F.3d 1035, 1039, 34 USPQ 2d 1467, 1470 (Fed. Cir. 1995)).

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With possession being the key to satisfying the written description requirements of 35 U.S.C. § 112, first paragraph, the test for establishing that adequate written description simply concerns showing evidence that such possession existed. As has been repeatedly stated by both the Court of Customs and Patent Appeals and the Federal Circuit:

[A]ll that is required is that it [the applicant] *reasonably conveyed* to persons skilled in the art that, as of the filing date thereof, the inventor had *possession* of the subject matter later claimed by him. (See *Elselstein*, 52 F.3d at 1039, 34 USPQ2d 1467, 1470 (emphasis added)). See also, *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158, 47 USPQ2d 1829, 1832 (Fed. Cir. 1998) (“To meet this requirement, the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed”).

Thus, legal precedent makes it clear that it is well-established, indeed axiomatic, that, to comply with written description requirement of 35 U.S.C. § 112, first paragraph, all that is required is that applicant “reasonably convey” to persons having ordinary skill in the art that, as of the filing date, the inventor possessed the subject matter at issue.

#### Application of Law to Claims

The Office Action argues that Applicants’ written description does not support any of the following recitations of claim 33:

using a camera to capture at least one image;  
using said camera to capture information associated with said  
image, wherein said information is stored in a database.

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Applicants strongly disagree with the Office Action, and will show where the written description fully supports each of these recitations.

First, Applicants clearly had possession of the claimed "using a camera to capture at least one image." Block 101 of Applicants' FIG. 1 states "generate photographs." The specification clearly states that a camera can be used to capture an image:

The user may generate the photographs utilizing any type of mechanism as desired by the user. For example, the user may take the photographs with an inexpensive disposable camera. Alternatively, the user may take the photographs with a relatively complex digital camera. (Emphasis added: P. 6, lines 2-5).

Second, Applicants clearly had possession of the claimed "using said camera to capture information associated with said image." Block 103 of Applicants' FIG. 1 states "associate meta-data with photograph." The specification clearly states that a camera can capture information associated with an image:

In step 103, meta-data (if the photograph was taken by a camera capable of producing meta-data) is associated with the provided photograph. Meta-data refers to data that is automatically produced when a photograph is taken. For example, meta-data would include the GPS coordinates if the photograph was taken by a GPS receiver-enabled digital camera. Also, many digital cameras associate time and date information with each photograph. Time and date meta-data may be associated with the photograph for retrieval purposes. Other meta-data may be associated with the photograph such as a voice annotation. The meta-data may identify the type of camera utilized. For example, the meta-data may identify the model number of the digital camera. The preceding examples are merely exemplary. Any type

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**of auto-generated meta-data may be associated with the photograph depending upon the capability of a given camera.**  
(Emphasis added: P. 7, lines 6-16).

Third, Applicants clearly had possession of the claimed "said information is stored in a database." Block 105 of Applicants' FIG. 1 states "place data and thumbnail representation in database." The specification clearly states that information associated with the image (example, meta-data) is stored in a database:

**In step 105, the meta-data, user data, and a thumbnail representation generated from the full digital representation are placed into the database.** (Emphasis added: P. 7, lines 21-22).

In view of the above, Applicants assert that the written description requirement of 35 U.S.C. § 112, first paragraph, has been satisfied for the rejected claim recitations. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

## **II. Claims Rejections: 35 USC § 112**

Claim 33 is rejected under 35 USC § 112, first paragraph, as failing to comply with the written description requirement. This rejection is traversed.

### **Overview of Law**

The law is clearly articulated in connection with section I above.

### **Application of Law to Claims**

The Office Action argues that Applicants' written description does not support the recitation of claim 33 stating that a "physical label" is generated. Applicants strongly disagree with the Office Action.

First, Applicants acknowledge that the specification does not use the word "physical." The law, however, does not require that every word in a claim appear in the

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specification. Instead, the law requires that Applicant reasonably convey to persons having ordinary skill in the art that they had possession of the subject matter. Applicants clearly had possession of the claimed "physical label." Block 108 of Applicants' FIG. 1 states "generate and print matching envelope labels." Block 109 of Applicants' FIG. 1 further states "place labels on envelopes." Thus, blocks 108 and 109 convey that labels are printed, and labels are placed on envelopes. Clearly, the labels are "physical." The specification further supplements the figure and reasonably conveys that the labels are physical:

If not, the database application generates and prints a user label or user labels that may be affixed to a storage structure or structures which will be used to retain the various photographs (step 108). For example, the user may place the photographs back into the developer envelope. The label may be affixed onto the developer envelope. Alternatively, the present invention may print label information directly onto a storage envelope if desired by a user.

Additionally, the unique identifier is printed on the label. Moreover, the database application preferably allows the user to provide a more meaningful text description that will be associated with the storage structure if desired. Additionally or alternatively, the user may select a thumbnail representation to be printed on the label. For example, the user may select a beach view photograph to be associated with an envelope of photographs taken in Hawaii.

In step 109, the user places the label on the envelope or other structural container such as a photograph album or box. (Emphasis added: P. 8, lines 2-18).

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In view of the above, Applicants assert that the written description requirement of 35 U.S.C. § 112, first paragraph, has been satisfied for the rejected claim recitations. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, first paragraph, be withdrawn.

### **III. Claim Rejections: 35 USC § 103**

Claims 33-39, 40-45, 53-55, and 60-63 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,483,570 (Slater) in view of USPN 6,629,104 (Parulski). This rejection is traversed.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Applicants assert that the rejection does not satisfy these criteria.

#### **Overview of Slater & Parulski**

As a precursor to the arguments, Applicants provide an overview of Slater and Parulski.

Slater teaches apparatus and methods for processing film at photofinishing laboratories (see FIGS. 1A and 1B). Customers place undeveloped film in an envelope and give the envelope to a retailer for developing (7: 1-25). The envelopes are sorted, and the film undergoes extensive processing in order to develop the film (8: 1-67). During development of the film, an operator views images on a display and provides a content descriptor or content identification for the images (11: 12-54). A determination is then made whether a match occurs between the content identification and a stored image content identification (12: 10-53).

Parulski teaches methods for adding personal information to images so the images can be categorized in a database (1: 58-61). A user is asked a series of personal questions

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in order to create metadata labels for tracking images (5: 65 – 6: 16). These labels are stored and later assigned to images that the user captures and downloads (6: 16-19).

**No Suggestion/Motivation to Modify/Combine References**

For at least the following reasons, no suggestion or motivation exists to modify or combine Slater in view of Parulski.

First, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Slater is directed to apparatus and methods for processing film at photofinishing laboratories. FIGS. 1A and 1B show such a photofinishing laboratory. By contrast, Parulski is directed to methods for adding personal information to images so the images can be categorized in a database (1: 58-61). A user is asked a series of personal questions in order to create metadata labels for tracking images (5: 65 – 6: 16). These labels are stored and later assigned to images that the user downloads (6: 16-19).

The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In Slater, the Background section discusses that after a photographer gives a roll of film to a processing laboratory, the photographer may want to display the images on products other than paper. "It would be desirable if some way was provided to readily make available to a photographer a type of produce or service she might already want, with little or no effort to locate such a product or service on the photographer's part" (2: 12-15). By contrast, Parulski solves a completely different problem. In Parulski, the Background section discusses the problems with conventional software applications for categorizing images. "Unfortunately, these conventional software applications make it

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difficult for an untrained consumer to categorize their images in a way that enables them to later locate their favorite images of a selected subject" (1:47-51).

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). In light of the completely different inventions and problems being solved in Slater and Parulski, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicants respectfully assert that a *prima facie* case of obvious has not been established.

#### **No Reasonable Expectation of Success**

No reasonable expectation of success has been established for modifying Slater with the teachings of Parulski to arrive at the recitations of the claims. In other words, even assuming *arguendo* that Slater and Parulski are combinable (which they are not), the combination will not yield a reasonable expectation of success.

Slater teaches apparatus and methods for processing film at photofinishing laboratories. FIGS. 1A and 1B show the complex nature of such processing. Parulski teaches methods for users to add personal information to images so the images can be categorized in a database. Users are asked a series of personal questions in order to create metadata labels for tracking images. The complex undertakings in processing film rolls taught in Slater cannot successfully be combined with the method taught in Parulski for personalizing information in a database.

In view of these deficiencies, the Office Action has failed to establish a reasonable expectation of success with a combination or modification of Slater and Parulski. Therefore, the *prima facie* case of obviousness has not been established.

#### **Hindsight Construction (Picking and Choosing)**

The Office Action combines two unrelated references (Slater and Parulski) to allegedly obviate the claims. Applicants respectfully assert that the Examiner is using



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knowledge of Applicants' invention and then performing hindsight reconstruction to show the various claim elements. In other words, the Office Action is picking and choosing teachings from numerous isolated references. On this subject, the case law is clear: One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

For at least these reasons, a *prima facie* case of obvious has not been established.

#### **All Elements Not Taught or Suggested**

All of the elements of the claims are not taught or suggested in Slater and Parulski. In other words, evening assuming *arguendo* that Slater and Parulski are successfully combinable (which they are not), the alleged combination does not teach or suggest all the elements in the claims. Examples for various independent and dependent claim groups are provided below.

#### **Claim 33**

As one example, claim 33 recites using a camera to capture both an image and information associated with the image. The claim then recites that this information is used to generate a "physical label ... adapted to be affixed to a storage device" (emphasis added). Slater in view of Parulski does not teach or suggest this recitation. The Office Actions cites Slater at column 6, lines 1-8 and Parulski at column 3, lines 14-26. Applicants respectfully disagree.

Column 6, lines 1-8 of Slater discusses different examples for "content identification." In Slater, the term "content identification" means identifying one or more objects in a scene of an image (5: 51-53). Content identification has nothing whatsoever to do with a physical label or affixing a physical label to a storage device.

Column 3, lines 14-26 in Parulski discusses adding labels to images. In Parulski, however, the labels are electronic. Parulski never teaches or even suggests that such labels are physical labels or that such labels can be affixed to a storage device.

For at least these reasons, claim 33 and its dependent claims are allowable over Slater in view of Parulski.

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As another example, claim 33 recites capturing an image with a camera and then using the "camera to capture information associated with said image." The Office Action argues that this recitation is taught in Parulski at column 2, lines 55-63. Applicants respectfully disagree.

Column 2, lines 55-63 in Parulski teaches prompting a user to create electronic labels for images that will be captured at a later time. Parulski is in direct contrast to the recitations of the claim. Claim 33 recites that the camera captures information associated with the image. By direct contrast, Parulski teaches that a user provides information about future images. The camera does not generate this information. Instead, a user generates the information before the images are captured.

For at least these reasons, claim 33 and its dependent claims are allowable over Slater in view of Parulski.

#### **Claim 35**

Claim 35 recites that metadata is formed during the capture of an image with a camera. The Office Action argues that this recitation is taught in Slater at column 7, lines 51-54. Applicants respectfully disagree.

Column 7, lines 51-54 in Slater describes a label on a bag. The label identifies the film in the bag. In Slater, the images are already captured and presented to a laboratory for developing. As such, Slater is in direct contrast to the claim language: "forming metadata during said capture of said image" (emphasis added). In other words, claim 35 recites that the metadata is formed when the image is captured. Slater teaches a putting a label on a bag after the images are captured and given to a laboratory for developing.

For at least these reasons, claim 35 is allowable over Slater in view of Parulski.

#### **Claim 42**

As one example, claim 42 recites "searching a database with a query to locate a printed copy of one image of the plurality of images." The Office Action argues that this recitation is taught in Slater at column 6, lines 31-43. Applicants respectfully disagree.

Column 6, lines 31-43 in Slater teaches how to match two different stored images (i.e., a generated image content identification with a stored image content identification).

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This section of Slater has nothing whatsoever to do with **locating a printed copy** of an image. Again, Slater is concerned with matching two electronic images, not locating a printed copy among a plurality of printed copies in a storage device.

For at least these reasons, claim 42 is allowable over Slater in view of Parulski.

As another example, claim 42 recites "searching the storage container for the printed copy of the one image." The Office Action argues that this recitation is taught in Slater at column 7, lines 30-35. Applicants respectfully disagree.

Column 7, lines 30-35 in Slater teaches that retail stores can develop film for customers. When a customer deposits film at the retail store, the customer puts the film in an envelope and writes identifying information (example, his/her address) on the envelope. This section of Slater teaches or suggests nothing about searching a storage container for a printed copy of an image.

For at least these reasons, claim 42 is allowable over Slater in view of Parulski.

#### **Claim 44**

Claim 44 recites "forming a thumbnail representation of the image on the label." The Office Action argues that this recitation is taught in Slater at column 7, lines 51-54. Applicants respectfully disagree.

Column 7, lines 51-54 in Slater describes a label on a bag. Slater never teaches or even suggests that this label includes a thumbnail of the image. Slater is completely silent about putting a thumbnail on this label.

For at least these reasons, claim 44 is allowable over Slater in view of Parulski.

#### **Claim 45**

As one example, claim 45 recites "searching the database with a query to locate the printed copy of the image." The Office Action argues that this recitation is taught in Slater at column 6, lines 31-43. Applicants respectfully disagree.

Column 6, lines 31-43 in Slater teaches how to match two different stored images (i.e., a generated image content identification with a stored image content identification). This section of Slater has nothing whatsoever to do with **locating a printed copy** of an

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image. Again, Slater is concerned with matching two electronic images, not locating a printed copy among a plurality of printed copies in a storage device.

For at least these reasons, claim 45 is allowable over Slater in view of Parulski.

As another example, claim 45 recites "providing the thumbnail representation of the image." The Office Action argues that this recitation is taught in Slater at column 10, lines 19-27. Applicants respectfully disagree.

Column 10, lines 19-27 in Slater describes an image preview station wherein an operator can view images on a computer screen. At this cited location, Slater never teaches or even suggests that the images on the computer display are thumbnails. Instead, Slater merely says that previews of images are provided on a display.

For at least these reasons, claim 45 is allowable over Slater in view of Parulski.

#### **Claim 53**

As one example, claim 53 recites generating information that identifies a captured image. The claim then recites "generating physical label that is adapted to be affixed to a storage device adapted to hold a printed copy of said image" (emphasis added). Slater in view of Parulski does not teach or suggest this recitation. The Office Actions cites Slater at column 6, lines 1-8 and Parulski at column 3, lines 14-26. Applicants respectfully disagree.

Column 6, lines 1-8 of Slater discusses different examples for "content identification." In Slater, the term "content identification" means identifying one or more objects in a scene of an image (5: 51-53). Content identification has nothing whatsoever to do with a physical label or affixing a physical label to a storage device.

Column 3, lines 14-26 in Parulski discusses adding labels to images. In Parulski, however, the labels are electronic. Parulski never teaches or even suggests that such labels are physical labels or that such labels can be affixed to a storage device.

For at least these reasons, claim 53 and its dependent claims are allowable over Slater in view of Parulski.

As another example, claim 53 recites "generating information identifying an image at the time said image is captured" (emphasis added). In other words, when an image is captured, information identifying the image is generated. Slater in view of

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Parulski does not teach or suggest this recitation. The Office Actions cites Parulski at column 2, lines 28-38. Applicants respectfully disagree.

Column 2, lines 28-38 of Parulski are a brief description of various drawings. This section of Parulski has nothing whatsoever to do with the noted recitations.

For at least these reasons, claim 53 and its dependent claims are allowable over Slater in view of Parulski.

As yet another example, claim 53 recites "automatically producing meta-data associated with said image" (emphasis added). Slater in view of Parulski does not teach or suggest this recitation. The Office Actions cites Parulski at column 3, lines 9-13. Applicants respectfully disagree.

Column 3, lines 9-13 of Parulski teaches that a user enters personal information. This information is used to generate labels that are stored as meta-data. In Parulski, the meta-data is not automatically produced. Instead, a user enters the meta-data.

For at least these reasons, claim 53 and its dependent claims are allowable over Slater in view of Parulski.

#### **Claim 54**

Claim 54 recites generating information identifying an image at the time the image is captured. This identifying information is "automatically generated by a device capturing said image." Slater in view of Parulski does not teach or suggest this recitation. The Office Actions cites Slater at column 14, lines 6-8. Applicants respectfully disagree.

Column 14, lines 6-8 of Slater teaches that after undeveloped film is sent to a processing laboratory, an operator can identify the images on a display and use a computer to provide the images with a content identification. This teaching in Slater is in direct contrast to the claim recitations. Claim 54 states that the identifying information is generated by the device that captures the image. In Slater, a user uses a camera to capture an image. This camera, however, is not the same device used to generate the identification discussed in Slater at column 14, lines 6-8.

For at least these reasons, claim 54 is allowable over Slater in view of Parulski.

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### **Claim 55**

Claim 55 recites "printing the thumbnail representation on the label." The Office Action argues that this recitation is taught in Slater at column 11, lines 30-46. Applicants respectfully disagree.

Column 11, lines 30-46 in Slater describes that an operator in a finishing laboratory can view thumbnail images on a computer display. Slater never teaches or even suggests that these thumbnail images are printed on a label. Slater is completely silent about putting a thumbnail on this label.

For at least these reasons, claim 55 is allowable over Slater in view of Parulski.

### **Claim 59**

As one example, claim 59 recites "generating a label to affix to a storage device for holding a printed copy of said images." The Office Actions cites Slater at column 6, lines 1-8 and Parulski at column 3, lines 14-26. Applicants respectfully disagree.

Column 6, lines 1-8 of Slater discusses different examples for "content identification." In Slater, the term "content identification" means identifying one or more objects in a scene of an image (5: 51-53). Content identification has nothing whatsoever to do with a label that is affixed to a storage device for holding printed copies of images.

Column 3, lines 14-26 in Parulski discusses adding labels to images. In Parulski, however, the labels are electronic. Parulski never teaches or even suggests that such labels are physical labels are affixed to a storage device for holding printed copies of images.

For at least these reasons, claim 59 and its dependent claims are allowable over Slater in view of Parulski.

As another example, claim 59 recites "inputting, from a user into said digital camera, user data associated with each said image." The Office Action does not even address these claim recitations. Applicants argue that nowhere do Slater and Parulski teach or suggest such recitations.

For at least these reasons, claim 59 and its dependent claims are allowable over Slater in view of Parulski.

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As another example, claim 59 recites "automatically generating, with said digital camera, meta-data associated with each said image, wherein said meta-data comprises said user data, and wherein said meta-data for each said image is generated at a time said image is captured." The Office Action does not even address these claim recitations. Applicants argue that nowhere do Slater and Parulski teach or suggest such recitations.

For at least these reasons, claim 59 and its dependent claims are allowable over Slater in view of Parulski.

#### **Claim 60**

Claim 60 recites "generating a thumbnail of said image on said label." The Office Action argues that this recitation is taught in Slater at column 11, lines 20-30. Applicants respectfully disagree.

Column 11, lines 20-30 in Slater describes that an operator in a finishing laboratory can view thumbnail images on a computer display. Slater never teaches or even suggests that these thumbnail images are printed on a label. Slater is completely silent about putting a thumbnail on this label.

For at least these reasons, claim 60 is allowable over Slater in view of Parulski.

#### **Claim 63**

Claim recites storing in a computer three different elements: meta-data, user data, and an identifier. The Office Action argues that this recitation is taught in Parulski at column 6, lines 1-8. Applicants respectfully disagree.

Column 6, lines 1-8 in Parulski teaches that users are asked personal questions in order to generate meta-data labels. These labels are derived from emotional judgment of the user. Parulski does teach storing meta-data. By contrast, claim 63 recites three different elements: meta-data, user data, and an identifier. Parulski does not teach or suggest all three of these elements.

For at least these reasons, claim 63 is allowable over Slater in view of Parulski.

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#### **IV. Claim Rejections: 35 USC § 103**

Claims 39 and 56-58 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,483,570 (Slater) in view of USPN 6,629,104 (Parulski) and USPN 6,426,801 (Reed).

Dependent claims 39 depends from independent claim 33, and dependent claims 56-58 depend from independent claim 53. As discussed in section III, independent claims 33 and 53 are allowable over Slater and Parulski. Reed fails to cure the deficiencies of Slater and Parulski. Thus, for at least the reasons state above in section III, claims 39 and 56-58 are allowable over the art of record.

#### **V. Claim Rejections: 35 USC § 103**

Claim 39 is rejected under 35 USC § 103(a) as being unpatentable over USPN 6,483,570 (Slater) in view of USPN 6,629,104 (Parulski) and USPN 6,813,395 (Kinjo).

Dependent claims 39 depends from independent claim 33. As discussed in section III, independent claim 33 is allowable over Slater and Parulski. Kinjo fails to cure the deficiencies of Slater and Parulski. Thus, for at least the reasons state above in section III, claims 39 is allowable over the art of record.



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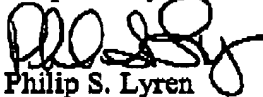
### CONCLUSION

In view of the above, Applicants respectfully request the Board of Appeals to reverse the Examiner's rejection of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. (281) 514-8236, Facsimile No. (281) 514-8332. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,



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#### CERTIFICATE UNDER 37 C.F.R. 1.8

The undersigned hereby certifies that this paper or papers, as described herein, is being transmitted to the United States Patent and Trademark Office facsimile number 571-273-8300 on this 13<sup>th</sup> day of April, 2006.

By

  
Name: Carrie McKerley

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### **VIII. Claims Appendix**

33. A method comprising:  
using a camera to capture at least one image;  
using said camera to capture information associated with said image, wherein said information is stored in a database; and  
using said information to generate a physical label having an identifier, wherein the label is adapted to be affixed to a storage device that is adapted to hold printed copies of the plurality of images.
34. The method of claim 33 wherein said image is a digital image, further comprising:  
storing each image of the plurality of images in said database.
35. The method of claim 33, wherein capturing said information comprises:  
forming metadata during said capture of said image.
36. The method of claim 33, wherein capturing said information comprises:  
accepting said information from a user.
37. The method of claim 33 wherein the information is at least one of:  
GPS coordinates;  
a time;  
a date;  
camera information;  
an audio file;  
at least one keyword;  
a description of subject matter of the image; and  
an event associated with the image.

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38. The method of claim 33 wherein the storage device is selected from the group consisting of:

- an envelope;
- an album; and
- a box.

39. The method of claim 33, further comprising:  
forming at least a portion of the plurality of images by a digital camera.

40. The method of claim 33, further comprising:  
forming at least a portion of the plurality of images by a non-digital camera; and  
converting the at least a portion of the plurality of images into digital form.

41. The method of claim 33, further comprising:  
placing the label on the storage device; and  
placing printed copies of the plurality of images in the storage device.

42. The method of claim 33, further comprising:  
searching the database with a query to locate a printed copy of one image of the plurality of images;  
providing the identifier associated with the one image;  
locating the storage container with the label having the identifier;  
searching the storage container for the printed copy of the one image.

43. The method of claim 42 wherein the query comprises at least one of:  
GPS coordinates;  
a time;  
a date;  
camera information;  
an audio file;  
at least one keyword;  
a description of subject matter of the one image; and  
an event associated with the one image.

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44. The method of claim 33 further comprising:  
forming a thumbnail representation of the image on the label.

45. The method of claim 44, further comprising:  
searching the database with a query to locate the printed copy of the image; and  
providing the thumbnail representation of the image.

46. (Withdrawn) A system comprising:  
a storage container that holds printed copies of a plurality of images;  
a printer that provides a label having an identifier, wherein the label is affixed to  
the storage container; and  
a database for holding information associated with at least one image of the  
plurality of images, and associates each of the images of the plurality of images with the  
identifier.

47. (Withdrawn) The system of claim 46, wherein the database also stores  
each image of the plurality of images.

48. (Withdrawn) The system of claim 46, wherein the information is at least  
one of:

GPS coordinates;  
a time;  
a date;  
camera information;  
an audio file;  
at least one keyword;  
a description of subject matter of the image; and  
an event associated with the image.

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49. (Withdrawn) The system of claim 46, wherein the storage device is selected from the group consisting of:

- an envelope;
- an album; and
- a box.

50. (Withdrawn) A system for storing a printed copy of an image, comprising:

- means for providing information associated with the image;
- means for storing a printed copy of the image;
- means for generating a label having an identifier, wherein the label is adapted to be affixed to the means for storing; and
- means for storing the information and for associating the identifier with the image.

51. (Withdrawn) The system of claim 50, wherein the information is at least one of:

- GPS coordinates;
- a time;
- a date;
- camera information;
- an audio file;
- at least one keyword;
- a description of subject matter of the image; and
- an event associated with the image.

52. (Withdrawn) The system of claim 51, further comprising:

- means for searching the means for storing the information and for associating the identifier with the image to locate the means for storing a printed copy of the image via the identifier;
- wherein the means for searching uses a query that includes at least a portion of the information.

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53. A method comprising:  
generating information identifying an image at the time said image is captured;  
automatically producing meta-data associated with said image;  
providing the meta-data into a database;  
generating a physical label that is adapted to be affixed to a storage device  
adapted to hold a printed copy of said image, wherein said label has an identifier  
generated from said identifying information; and  
providing said identifier into said database.

54. The method of claim 53 wherein said identifying information is  
automatically generated by a device capturing said image.

55. The method of claim 53 further comprising:  
providing a thumbnail representation of the image into the database; and  
printing the thumbnail representation on the label.

56. The method of claim 53 wherein the meta-data includes global position  
system (GPS) coordinates acquired at a time when the image is produced.

57. The method of claim 53 further comprising:  
searching for the image in the database by submitting a query to the database,  
wherein the query includes criteria associated with the meta-data.

58. The method of claim 57 further comprising:  
displaying a thumbnail representation of the image upon matching the query to  
the image in the database.

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59. A method comprising:  
capturing a plurality of images with a digital camera;  
inputting, from a user into said digital camera, user data associated with each said image;  
automatically generating, with said digital camera, meta-data associated with each said image, wherein said meta-data comprises said user data, and wherein said meta-data for each said image is generated at a time said image is captured;  
providing each said image and its associated meta-data into a computer; and  
generating a label to affix to a storage device for holding a printed copy of said images, wherein said label identifies said printed copies with an identifier image generated from said meta-data.

60. The method of claim 59 further comprising:  
generating a thumbnail of said image on said label.

61. The method of claim 59 further comprising:  
organizing said images on said computer using said meta-data.

62. The method of claim 59 further comprising:  
automatically creating, with said computer, said identifier.

63. The method of claim 59 further comprising:  
storing, in said computer, said meta-data, said user data, and said identifier.

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**IX. EVIDENCE APPENDIX**

None.



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**X. RELATED PROCEEDINGS APPENDIX**

None.